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Docket No. TOL-100
Serial No. 09/997,492Remarks

Claims 45-50 were pending in the subject application. By this amendment, the applicant has amended claim 45. No new subject matter has been added by these amendments. Support for the amendments can be found throughout the subject specification including, for example, at page 3, paragraph 19. Accordingly, claims 45-50 are now before the Examiner for her consideration.

The amendment to claim 45, as set forth herein, has been done in an effort to lend greater clarity and specificity to the claimed subject matter and to expedite prosecution. The amendment should not be taken to indicate the applicant's agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claim now presented, in view of the amendment set forth herein, is earnestly solicited.

Claims 45-49 have been rejected under 35 U.S.C. §103(a) as being obvious over Merrifield (U.S. Patent No. 316,288).

The subject specification provides unique methods for hotel guests to communicate instructions to housekeeping staff. The method is particularly useful in that direct communication between guest and staff is circumvented and the instructions, as provided by the invention, will not be misplaced, lost, or not seen and used by the guest. Because, as discussed below, the Merrifield reference neither discloses nor suggests a method for a hotel guest to communicate specific commands to housekeeping staff, the subject invention cannot reasonably be said to be obvious.

As stated in the Office Action, Merrifield teaches an indicator for communicating the status of rooms, specifically the vacancy status. Merrifield fails to disclose or suggest a method for communicating instructions, wherein a hotel guest selects a command for housekeeping staff using a hotel communication device of the invention and, the hotel staff seeing the command selected by the hotel guest, carries out the indicated instruction. Rather, Merrifield only makes reference to a device whose purpose is to provide a means for easy assessment of whether a room is vacant or occupied (see col. 1, lines 15-21; 25-28; col. 2, lines 75-84; claim 1). Thus, nothing in the Merrifield reference discloses, or even suggests, providing a method for communicating a hotel guest's instructions to housekeeping staff.

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A finding of obviousness is proper only when the prior art contains a suggestion or teaching of the claimed invention. Here, Merrifield fails to disclose or suggest the applicant's unique method for communicating instructions between a hotel guest and housekeeping staff. It is only the applicant's disclosure that provides such a teaching, and the applicant's disclosure cannot be used to reconstruct the prior art for a rejection under §103. This was specifically recognized by the CCPA in *In re Sponnoble*, 56 CCPA 823, 160 USPQ 237, 243 (1969):

The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statements; that is we must review the prior art without reading into that art appellant's teachings. *In re Murray*, 46 CCPA 905, 268 F.2d 226, 112 USPQ 364 (1959); *In re Sprock*, 49 CCPA 1039, 301 F.2d 686, 133 USPQ 360 (1962). The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole, obvious. *In re Leonor*, 55 CCPA 1198, 395 F.2d 801, 158 USPQ 20 (1968). (Emphasis in original)

The mere fact that the purported prior art could have been modified or applied in a manner to yield applicant's invention would not have made the modification or application obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Moreover, as expressed by the CAFC, to support a §103 rejection, "[b]oth the suggestion and the expectation of success must be founded in the prior art" *In re Dow Chemical Co.*, *supra* at 1531. In the Merrifield reference cited in support of the §103 rejection, one finds neither.

Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection set forth under 35 U.S.C. §103(a).

Claim 50 has been rejected under 35 U.S.C. §103(a) as being obvious over Merrifield (U.S. Patent No. 3,162,888) in view of Bianco *et al.* (U.S. Patent No. 5,948,498). The applicant respectfully traverses this ground for rejection because the cited references, either alone or in combination, do not disclose or suggest the advantageous method of the current invention.

The shortcomings of the Merrifield reference have been discussed above in detail. The Bianco *et al.* reference does not cure, or even address, these shortcomings. As noted by the instant Office Action, the Bianco *et al.* reference merely pertains to a multi-purpose message board that can

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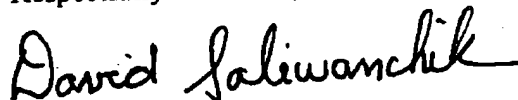
be mounted to a wall. There is no discussion in the Bianco *et al.* reference of methods for providing hotel guests with a means for communicating instructions to housekeeping staff. Thus, when the Bianco *et al.* reference is read in conjunction with the Merrifield reference, which only describes a device for displaying the vacancy status of a room, the prior art, when read as a whole, fails to teach or suggest a method for communicating instructions from a hotel guest to housekeeping staff. Accordingly, the applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §103 based on the Merrifield and Bianco *et al.* references.

In view of the foregoing remarks and the amendment to claim 1 as set forth above, the applicant believes that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicant invites the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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